

REMARKS

By this amendment, claims 1-38 are pending, in which claims 1-3, 8-9, 11, 16, 18, 23, 25, 31-33, and 38 are currently amended, and no claims are canceled, withdrawn, or newly presented. Claims 2-3, 8, 11, 18, 25, 32-33, and 38 were amended to resolve discovered informalities. No new matter is introduced. (*See, e.g.*, specification pars. 40-41)

The Office Action mailed March 23, 2005 rejected claims 1, 6-9, 14-16, 21-23, 28-31, and 36-38 under 35 U.S.C. § 102(e) as anticipated by *Ooki et al.* (U.S. 6,240,518) and claims 2-5, 10-13, 17-20, 24-27, and 32-35 as obvious under 35 U.S.C. § 103(a) based on *Ooki et al.* in view of *Makansi et al.* (U.S. 6,771,597). The rejections of the claims are respectfully traversed because the applied art neither discloses nor suggests the recited features of the claims.

In the interests of advancing prosecution, independent claims 1 and 16 have been amended to recite, “receiving a selection message **from the client in response to the forwarded portion** specifying whether the remaining portion of the information should be retrieved,” claim 9 has been amended to recite, “wherein the communication interface receives a selection message from a client **in response to receipt of the retrieved portion**, the selection message specifying whether a remaining portion of the information should be retrieved, the remaining portion of the information being forwarded to the client,” claim 23 has been amended to recite, “wherein **in response to the forwarded portion**, the client transmits a selection message specifying whether the remaining portion of the information should be retrieved to the server,” and claim 31 has been amended to recite, “receiving a selection message **from the client in response to the forwarded portion**, specifying whether the remaining portion of the information should be retrieved,” which is neither disclosed nor suggested by either *Ooki et al.* or *Makansi et al.*, individually nor in any reasonable combination.

As an example, amended independent claim 1 recites a “method for retrieving information over a packet switched network, the method comprising: receiving a request message from a client for information; forwarding a portion of the information to the client in response to the request message; receiving a selection message **from the client in response to the forwarded portion** specifying whether the remaining portion of the information should be retrieved; and forwarding the remaining portion of the information to the client.”

In stark contrast, *Ooki et al.* (col. 1: 47-49) is directed to accessing restricted information in a schedule of a user. A personal schedule contains one portion that is open to any user of a client-server system (such as appointed day and hours) and another portion that is not open to all users of the system (such as destination of a business trip or dealer) (i.e., a closed portion). (col. 1: 59-63) When a user requests for accessing schedule data, the user’s ID is checked against the ID of the managed schedule to determine whether the user’s ID is permitted access to the closed portion of the requested schedule information. A user data management unit 14 operates to access a user data registration unit 41 for reading the schedule data user to be requested to be accessed and for transmitting the permitted portion to the user. (col. 5: 5-30)

There is no disclosure or suggestion by *Ooki et al.* of “receiving a selection message **from the client in response to the forwarded portion** specifying whether the remaining portion of the information should be retrieved,” as recited by claim 1.

Similarly, there is no disclosure or suggestion by *Ooki et al.* of “receiving a selection message **from the client in response to the forwarded portion** specifying whether the remaining portion of the information should be retrieved,” as recited by claim 16, “wherein the communication interface receives a selection message from a client **in response to receipt of the retrieved portion**, the selection message specifying whether a remaining portion of the information should be retrieved, the remaining portion of the information being forwarded to the

client,” as recited by claim 9, “wherein **in response to the forwarded portion**, the client transmits a selection message specifying whether the remaining portion of the information should be retrieved to the server,” as recited by claim 23, or “receiving a selection message **from the client in response to the forwarded portion**, specifying whether the remaining portion of the information should be retrieved,” as recited by claim 31. Therefore, the rejection of claims 1, 19, 16, 23, and 31 should be withdrawn.

The rejection of dependent claims 6-8, 14-15, 21-22, 28-30, and 36-38, which depend from claims 1, 9, 16, 23, and 31, respectively, should be withdrawn for at least the same reasons as those discussed above with regard to their respective independent claims, and these claims are separately patentable on their own merits.

The deficiencies of *Ooki et al.* are not cured by the addition of *Makansi et al.* Although not precisely tracking the language of claims 2 and 3, the Office Action, in its obviousness rejection based on *Ooki et al.* and *Makansi et al.* (p. 4) correctly acknowledges, “Ooki does not specifically disclose generating a response message that includes the portion of the information, the information being partitioned into a plurality of data types, the data types including viewable data, hidden data, encrypted data and state data,” and then states:

Makansi disclose this limitation in (fig. 2, 4 and col. 4, lines 55-67; col. 5, lines 60-65; col. 6, lines 15-24). It would have been obvious to person of ordinary skill in the art at the time invention was made to generate a response message that includes the portion of the information, the information being partitioned into a plurality of data types, the data types including viewable data, hidden data, encrypted data and state data as taught in Makansi with data security system disclosed in Ooki in order to securely identify and distinguish data thus providing easy access to the data by the user.

However, *Makansi et al.* (per col. 1: 7-9, col. 2: 8-12) is directed to transmitting messages as packets over a network using security steps to make the messages less susceptible to

unauthorized access. According to the cited portions of *Makansi et al.*, the message may be divided into packets formed with random sizes, with either the packets being encrypted or the message being encrypted prior to being divided into packets. (col. 5: 60-65) A message format may be used that includes a data portion 201, a header portion 202, and a trailer portion 203. (col. 4: 55-67, FIG. 2) The packets may be transmitted in random order by inserting ordering keys in the packets. The ordering keys may be “hidden” in the data portions of the packets or the ordering keys may be encrypted. (col. 6: 15-24)

As best understood, the Office Action equates the “information” recited at least by claim 2 with the packets of *Makansi et al.* However, nowhere does *Makansi et al.* disclose or suggest that the packets, or any contents of the packets, is “**partitioned**” into any data types, much less partitioned into data types “**including viewable data, hidden data, encrypted data, and state data.**” Moreover, the Office Action fails to explain how *Makansi et al.* discloses any type of “state data.” Thus, dependent claim 2 is allowable.

The rejections of the remaining dependent claims should be withdrawn for at least the same reasons as those discussed above with regard to the allowability of their respective independent claims, and these claims are separately patentable on their own merits. For example, dependent claim 3 recites, “the selection message includes encrypted data and state data associated with the information,” “decrypting the encrypted data; and transmitting new visible data of the information,” which includes language that is not addressed by the Office Action in its sweeping rejection of “Claims 2-3” on p. 4. This lack of explanation contravenes 35 U.S.C. § 132, which requires the Director to “notify the applicant thereof, stating the reasons for such rejection.” This section is violated if the rejection “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of

Patent Examining Procedure. For example, MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity.” Furthermore, MPEP § 706.02(j) indicates that: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”

As another example, dependent claim 4 recites, “preparing billing and reporting information based upon the state data; and generating a report based upon the state data.” Dependent claim 5 recites, “the information is directory assistance information that includes a name field, and a directory number.” Regarding both of these claims, the Office Action (p. 5; *see also*, p. 6, p. 7) states, “Official notice is taken that preparing billing and reporting information based upon the state data; and generating a report based upon the state data is well known in the art. One of ordinary skill in the art would have been motivated to employ billing and reporting information in order to conduct secure financial transaction.” As discussed previously, *Ooki et al.* and *Makansi et al.* fail to suggest or disclose the recited “state data” and the Office Action further stretches its assumptions to an Official Notice regarding preparing billing and reporting information based upon such “state data.” The APA requires the Patent Office to articulate and place on the record the “common knowledge” used to negate patentability. *In re Zurko*, No. 96-1285 (Fed. Cir., Aug. 2, 2001). *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. *See Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these

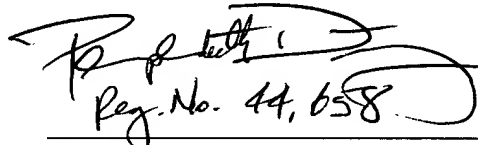
findings will not support an obviousness rejection). Therefore, if the Examiner maintains these rejections in a next action, Applicants request that specific factual findings and some concrete evidence to support such rejections be produced.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8501 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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